

## PRE-APPEAL BRIEF REQUEST FOR REVIEW

In the Final Office Action of September 16, 2009 claims 1-8, 27, 38, 39, 62, 77, 122, 133-150 were finally rejected. Claims 17, 23, 26, 28, 34, 37, 40, 46, 49, 63 and 72 stand objected to.

5        **INDEPENDENT CLAIMS**

Claims 1 and 5 are the only independent claims pending in the application. The Examiner provided two rejections to the independent claims. Applicants will refer to each of them separately.

10        **Claims 1-8, 27, 38, 39, 62, 67, 122 and 133-150 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Madden et al (US 6,135,955) in view of Bloch et al (Application of Computerized Tomography to Radiation Therapy and Surgical Planning. *Proceedings of IEEE*. 71(3): p. 351-355. March 1983).**

15        The rejection provided by the Examiner in the final office action is a copy of a rejection provided by Examiner Mehta regarding a related application 10/343,792 on September 2, 2009. The rejection therefore relates to the claims of application 10/343,792 and is irrelevant to the claims pending in the present application. Applicants respectfully submit that the copied rejection even includes a copied typographical error made by Examiner Mehta in said application ("co." instead of "col." in line 5 of the rejection on page 3). It is therefore unclear to applicants if the rejection was carefully  
20        reviewed by the Examiner for determining the relevance thereof to the present claims.

Applicants submit that not only does the language of the rejection provided by the Examiner not relate to the pending claims, the art cited in the rejection is also irrelevant to the subject matter claimed in the present application. For example, neither Madden nor Bloch refer to a first and a second radioactive emission detector which are  
25        physically connected by a flexible connector as required by both independent claims 1 and 5.

Applicants request the Panel to overturn the rejection which refers to claims other than the claims on file in the present application.

30        **Claims 1-8, 39, 62 and 77 stand rejected under 35 USC 102(e) as being anticipated by Weinberg (US 6,628,984) in view of Madden et al.**

The Examiner provides a rejection under 35 USC 102(e) in view of two pieces of art while 35 USC 102(e) allows only one piece of art to be used for basis of an anticipation rejection.

However, even if the Examiner referred to a rejection under 35 USC 103(a), the rejection is still erroneous as will be shown below.

The Examiner asserts that Weinberg discloses a system as claimed but does not explicitly disclose at least two detectors scanning a three dimensional surface which define body curvatures, while following contours of said three dimensional surface as recited in independent claims 1 and 5. However, according to the Examiner, Madden teaches said features in col. 9, lines 58-61 and col. 23, line 38-col. 24, line 4.

The Examiner failed to provide a *prima facie* case in support of the rejections of the claims due to the following reasons:

1. Weinberg fails to teach additional features claimed in independent claims 1 and 5, and
2. Madden fails to teach the limitations indicated by the Examiner as missing in Weinberg.

1. Weinberg fails to teach additional features claimed in independent claims 1 and 5

Weinberg fails to teach at least the following feature of claim 1: "wherein said flexible connection constrains said first and second radioactive emission detectors while said detectors follow contours of said three dimensional surface, to point towards the vicinity of said radioactivity emitting source" and similar feature in claim 5: "employing said radioactive emission detectors, while constraining said radioactive emission detectors to point towards the vicinity of said radioactivity emitting source, in scanning a three dimensional surface which define body curvatures, while following contours of said three dimensional surface". (emphasis added)

Weinberg discloses an embodiment where multiple detectors (or cameras) are used in Figs. 7 and 9. The multiple cameras are connected by cables to a same data acquisition device 110. These cables do not constrain the cameras, in particular, the cables of Weinberg do not constrain the cameras to point towards a specific area, such as the vicinity of a radioactivity emitting source.

It is submitted that applicants provided this argument in a telephonic interview with the Examiner conducted on June 4, 2009 and in a response filed by applicants on June 23, 2009. During the interview, the Examiner agreed with applicants that the cables

connecting the cameras in Weinberg do not constrain the cameras. Nevertheless, the Examiner failed to relate to this limitation in the present final action.

2. Madden fails to teach the limitations indicated by the Examiner as missing in Weinberg.

According to the Examiner, Madden in col. 9, lines 58-61 and col. 23, line 38-col. 24, line 4 teaches the following recitation of claims 1 and 5:

Claim 1 – "wherein said first and at least second radioactive emission detectors are configured for scanning a three dimensional surface which define body curvatures, while following contours of said three dimensional surface". Claim 5 – "employing said radioactive emission detectors ... in scanning a three dimensional surface which define body curvatures, while following contours of said three dimensional surface"

In col. 23, line 38-col. 24, line 4 Madden describes a spectral line shape. However, Madden's spectral line shape does not constitute a three dimensional surface which define body curvatures as recited in claims 1 and 5.

The spectral line shape 30Q in Madden is part of instrument 24 (see col. 16, lines 30-39) which processes signals of the detected radiation and provides analysis and different representations of the detected radiation. See for example, col. 14, lines 32-55, col. 15, lines 33-52, col. 16, lines 8-39 and col. 23, line 26-col. 24, line 29.

Thus, the spectral line shape of Madden is a graph of counts and detected energy as for example shown in Figs. 12 and 13 and is not of a three dimensional surface, certainly not of a three dimensional surface which define body curvatures.

Accordingly, it is submitted that the Examiner erred in asserting that Madden teaches a three dimensional surface which define body curvatures as recited in independent claims 1 and 5.

**DEPENDENT CLAIMS**

The dependent claims are patentable at least by virtue of their patentable parent claims. Nevertheless, at least some of the claims provide further patentability to their parent claims. It is submitted that the Examiner did not refer in his rejection to all the dependent claims specifically.

For example, claims 135-138 and 141-144 further define the three dimensional surface recited in claims 1 and 5. The Examiner did not provide a specific rejection to

these claims, i.e. did not specify under what law and what prior art the claims are rejected but only stated on page 7 of the final office action:

5       **"With respect to claims 135-139 and 141-145, Weinberg places the camera within a body cavity or to be used intraoperatively; so that one or many of the camera heads can be in a body cavity and other camera heads be outside the body cavity, or for all camera heads to be inside the body cavity as shown in figures 7-10, to derive a three dimensional representation of the lesion based on the integration of information from one are of interest to another (abstract, col. 2, lines 4-40)."**

10           It is unclear to applicants how this rejection refers to the recitations in the claims, or what combination, if at all, is suggested by the Examiner by this rejection. However, applicants respectfully submit that as indicated by the Examiner regarding the rejection to the independent claims provided on page 5 of the final office action, Weinberg fails to disclose detectors scanning a three dimensional surface which define body curvatures.  
15   Applicants submit that all the more does Weinberg fail to teach a three dimensional surface as further defined in claims 135-138 and 141-144.

          It is noted that applicants have previously requested, in a response filed in August 2008, that the Examiner specifically indicate the rejection against claims 134-139 and 141-145. However, the Examiner ignored applicants' request and never  
20   provided a complete rejection against these claims.

          Applicants provide claims 135-138 and 141-144 as an example only. The Examiner failed to provide proper rejections to most of the dependent claims and did not refer to each of the claims separately.

## 25   **Conclusion**

          Clearly, the Examiner erred in his rejections provided in the final office action.

          Applicants further object to the incompleteness of the rejections. As shown above, at least some of the rejections are copies of rejections provided by other Examiners in other applications. The copied rejections were not adapted to the subject  
30   matter claimed in the present application. In addition, the rejections do not correctly specify the laws on which they are based or the prior art applied against the claims. Moreover, applicants' previous requests for clearer and more concise rejections were ignored by the Examiner.

          Applicants have made an effort to conduct a telephonic interview with the  
35   Examiner in view of the unclear rejections provided in the final office action. The Examiner refused to conduct an interview without a presentation of a claim amendment

by applicants. Since the rejections are obscure and do not relate to the claimed subject matter, applicants see no reason for a claim amendment. As shown above, the Examiner did not provide any rejection that renders the pending claims unpatentable.

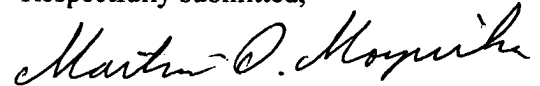
5 Applicants thus had no other choice then to apply to the pre-appeal conference for assistance in overturning the Examiner's obscure rejections in the final action.

Applicants believe that the final rejection of September 16, 2009 is not proper and without basis, specifically that the rejections arise from the Examiner not appreciating the claimed subject matter, the essence of the cited art and ignoring the patent laws. Applicant believes that independent claims 1 and 5 are patentable over the  
10 cited art.

Since independent claims 1 and 5 are patentable over the cited art, claims 1 and 5 and claims 2-4, 6-8, 27, 38, 39, 62, 77, 122, 133-150, respectively dependent therefrom, are in condition for allowance.

15 Applicant respectfully requests that the Panel issue a Notice of Allowance in this case.

Respectfully submitted,



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